

REMARKS

1. In response to the Office Action mailed October 9, 2007, Applicant respectfully requests reconsideration. Claims 1, 2, 4-9, 14, 20-24, 27-28, 30-31, and 89-115 were last presented for examination. In the outstanding Office Action, claims 1, 2, 4-9, 14, 20-24, 27-28, 30-31, and 89-115 were rejected. No claims were allowed or objected to. By the foregoing Amendments, claims 1, 2, 4-6, 30, 31, 93-96, and 106-112 were amended and claims 116-118 have been added. No claims have been canceled. Thus, upon entry of this paper, claims 1, 2, 4-9, 14, 20-24, 27-28, 30-31, and 89-118 remain pending in this application. Claim 1, 93 and 108 are independent claims.
2. Based upon the above Amendments and following Remarks, Applicant respectfully requests that all outstanding rejections be reconsidered and withdrawn.

Claim Rejections under 35 U.S.C. § 112

3. Claims 1-2, 4-9, 14, 20-24, 27-28, 30-31 and 89-92 were rejected under 35 U.S.C. § 112, ¶ 1 as allegedly failing to comply with the written description requirement. In addition, claims 1-2, 4, 7-9, 14, 20, 24, 27-28, 30-31, 89-93, 98-100, 104-110 were rejected under § 112, ¶ 2 as being allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant respectfully disagrees with the Examiner. Notwithstanding, Applicant amended claims 1 and 93 to delete the wording “without manual assistance.” Claim 108 did not include the “without manual assistance” claim language and thus the rejection of this claim is improper.

4. As amended, claim 1 recites, in part, “at least one protuberance configured to attach to the patient’s bone without manual insertion of the at least one protuberance into the bone...,” (see, Applicant’s claim 1, above.) Applicant respectfully submits that this amended claim language satisfies the requirements of 35 U.S.C. §112. Applicant would like to further note that this amended claim language is supported in the specification. For example, Applicant’s specification recites “[o]n implantation, such screws 404 are preferably not inserted or screwed into the bony surface of bone 206.” (see e.g., Applicant’s specification, ¶ [0049].) Amended independent claim 93 recites similar language, and thus likewise satisfies the requirements of 35 U.S.C. §112.

Claim Rejections under 35 U.S.C. §§ 102 and 103

5. Claims 1-2, 4, 7-9, 14, 20, 24, 27-28, 30-31, 89-93, 98-100, 104-110 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Pub. No. 2002/0019669 to Berrang (hereinafter “Berrang”) or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Berrang. Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Independent Claims 1 and 108

6. Independent claim 1 recites an implantable device for mounting to a patient’s bone comprising, among other things, “at least one protuberance configured to attach to the patient’s bone without manual insertion of the at least one protuberance into the bone, wherein said protuberance extends from said housing, the protuberance configured to osseointegrate with the patient’s bone and separate at least a portion of said outer surface of said housing from the patient’s bone when said housing is positioned adjacent the patient’s bone prior to osseointegration.” (see, Applicant’s claim 1, above.)

7. Berrang discloses a totally implantable cochlear prosthesis. Berrang discloses that “said housing can be conveniently sutured to the overlying tissue or attached to the underlying bone with sutures, or titanium screws.” (see, Berrang, at col. 3:37-39; see also at col. 14:22-25.) Berrang, however, does not teach or suggest that these screws are attached to the patient’s bone without manual insertion of the screws into the bone.

8. Similarly, Håkansson discloses a percutaneous bone anchoring transferring device which is anchored to the skull bone using screws. (see, Håkansson, col. 6, lines 30-33.) And, likewise, Håkansson fails to teach or suggest these screws are attached to the patient’s bone without manual insertion of the screws into the bone.

9. As such, Applicant’s respectfully submit that neither Berrang nor Håkansson whether taken alone or in combination teach or suggest “at least one protuberance configured to attach to the patient’s bone without manual insertion of the at least one protuberance into the bone,” as recited in Applicant’s claim 1. Applicant’s therefore respectfully request that the Examiner reconsider and withdraw the rejection of amended independent claim 1 for at least this reason.

10. Independent claim 108 recites, in part, “wherein said at least one osseointegrating protuberance is configured to be placed in direct contact with but not within the patient’s bone

and further configured to gradually sink into the patient's bone during osseointegration of said protuberance." (see, Applicant's claim 108, above).

11. In rejecting claim 108, the Office Action argues that this language merely requires that the device be capable of being placed in direct contact. (Office Action at page 5, ¶ 13). Applicant respectfully disagrees and asserts that the recited claim language recites specific structural limitations regarding the configuration of the claimed invention. That is, claim 108 does not recite that the claimed invention is "capable of" the recited limitations, but rather that it is specifically "configured to be placed in direct contact with but not within the patient's bone and further configured to gradually sink into the patient's bone during osseointegration of said protuberance." As noted, above, Berrang and Håkansson merely disclose screws for inserting into the patient's bone in attaching their respective devices to bone. Applicant therefore respectfully submits that neither Berrang nor Håkansson, whether taken alone or in combination, anticipate or render obvious Applicant's independent claim 108. Applicant's therefore respectfully request that the Examiner reconsider and withdraw the rejection of claim 108 for at least this reasons.

12. Moreover, Applicant's note that the present Office Action failed to respond to Applicant's arguments regarding claim 108 in Applicant's response dated September 8, 2008. As such, Applicant's respectfully request that if the Examiner wishes to maintain the rejection of claim 108, that Applicant's prior arguments be addressed.

Independent Claim 93

13. Independent claim 93, as amended, is directed to "[a] method for implanting an implantable device having a housing with an abutting surface configured to prevent osseointegration of the housing with a patient's bone and at least one osseointegrating protuberance extending from the housing." The method comprises the steps of:

forming a pocket on the patient's bone to receive the housing;

positioning the housing in said pocket such that the at least one protuberance is in direct contact with the outer surface of the patient's bone; and

allowing osseointegration of the at least one protuberance to occur without manual insertion of the at least one protuberance into the patient's bone,

whereby when the at least one protuberance is osseointegrated the abutting surface of the housing is not osseointegrated.

(*see*, Applicant's claim 93, above).

14. As an initial matter, the Office Action failed to specifically address the elements of independent claim 93 and corresponding disclosure in the cited references that are believed to disclose, teach or suggest the claimed elements. To anticipate a claim, the reference must teach every element of the claim. MPEP § 2131.01. As such, Applicant respectfully requests that the Examiner reconsider and withdraw the rejection to claim 93 for at least this reason.

15. Applicant further respectfully submits that there is no corresponding disclosure in the cited references of at least "allowing osseointegration of the at least one protuberance to occur without manual insertion of the at least one protuberance into the patient's bone," as recited in amended claim 93. Particularly, as discussed above, Berrang fails to disclose that the protuberances osseointegrate into the patient's bone as a way of implantation and instead discloses that "said housing can be conveniently sutured to the overlying tissue or attached to the underlying bone with sutures, or titanium screws." (Berrang, at col. 3, lines 37-39; *see also* col. 14, lines 22-25.)

16. Nor does Håkansson make up for the deficiencies of Berrang. In fact, Håkansson also specifically teaches away from Applicant's claimed method in requiring that the device is "firmly screwed to the bone tissue." (Håkansson, at col. 5, lines 26-29.)

17. Failing to disclose, teach or suggest each and every element of claim 93, no combination of Berrang and Håkansson anticipates or renders obvious Applicant's invention in claim 93 and claims 94-107 and 117 dependent therefrom.

Dependent claims

18. The dependent claims incorporate all the subject matter of their respective independent claims and add additional subject matter which makes them independently patentable over the art of record. Accordingly, Applicant respectfully asserts that the dependent claims are also allowable over the art of record.

19. Applicant respectfully submits that dependent claim 5 is allowable for at least the following additional reason. Claim 5 recites, in part, “two protuberances having longitudinal axes that lie in a plane at opposing angles relative to an implant axis.” (see, Applicant’s claim 5, above.) In rejecting claim 5, the Examiner appears to recognize that Berrang fails to disclose this limitation and instead relied on Håkansson for allegedly curing this defect of Berrang. (see, Office Action at pages 5-6, ¶ 16.) Applicant respectfully disagrees.

20. The Office Action states that “Håkansson teaches that it is known to use flanges and anchoring devices that are disposed at an opposing angle that is approximately 85 degrees and in the same plane as set forth in Figures 1 and 2 to provide anchoring means for the implantable device.” (Office Action, at pages 5-6, ¶ 16.) Figures 1 and 2 appear to be the sole basis for the Examiner’s rejection, as the Examiner has not cited or identified corresponding description of Figures 1 or 2 or any other disclosure in the specification. Although Figure 1 depicts the screws 3 implanted in the bone, the illustrated arms 12 of Håkansson lie in the same plane such that the screws 4 inserted into bone 1 are parallel with each other and perpendicular (90 degrees) to the surface of the bone 1. As such, the screws of Håkansson are not at opposing angles, but are illustrated as being parallel with one another.

21. Applicant’s therefore respectfully submit that neither Håkansson nor Berrang, whether taken alone or in combination, teach or suggest “two protuberances having longitudinal axes that lie in a plane at opposing angles relative to an implant axis,” as recited in Applicant’s claim 5. Applicant thus respectfully requests that the rejection of dependent claim 5 be reconsidered and withdrawn for at least this additional reason.

Conclusion

22. In view of the foregoing, this application should be in condition for allowance. A notice to his effect is respectfully requested.

23. Applicant reserves the right to pursue any cancelled claims or other subject matter disclosed in this application in a continuation or divisional application, cancellations and amendments of above claims, therefore, are not to be construed as an admission regarding the patentability of any claims and Applicant reserves the right to pursue such claims in a continuation or divisional application.

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